

BESSETTE et al.
Appl. No. 09/604,082
April 29, 2004

Attorney Docket No. 4380-107

REMARKS/ARGUMENTS

Claims 4, 19 and 45 are pending. Claims 4, 19 and 45 are amended to encompass infringing subject matter. Non-elected claims 7, 11, 13, 15, 17, 21, 23, 25, 27, 29, 31, 33, 35, 37, 39, 41, 43 and 46-49 are canceled without prejudice to, disclaimer of, the subject matter they contain.

ELECTION/RESTRICTION REQUIREMENT

The Office Action maintains and has made final the previously imposed Restriction Requirement. Applicants traverse the Restriction Requirement for the reasons of record. However, in view of the election of Group I (claims 4, 19 and 45), Applicants canceled non-elected claims 7, 11, 13, 15, 17, 21, 23, 25, 27, 29, 31, 33, 35, 37, 39, 41, 43, and 46-49, without prejudice to, or disclaimer of, the subject matter contained therein. Applicants reserve the right to file divisional applications therefor.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

The initial burden of establishing a *prima facie* basis to deny patentability rests upon the Patent Office. *In re Piasecki*, 223 U.S.P.Q. 785 (Fed. Cir. 1984). For a prior art reference to anticipate the claimed invention under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a **single reference**. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Moreover, it is incumbent on the Patent Office to identify wherein each and every facet of the claimed invention is disclosed in the singly applied reference. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. & Int. 1990). Where the Patent Office relies upon a theory of inherency, a basis in fact and/or cogent technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of

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the prior art must be provided. *Id.* at 1464. Applicants respectfully submit that the applied references used in the rejection of claim 4 does not satisfy this burden, as discussed below.

The Office Action rejects claim 4 under 35 U.S.C. § 102(b) as being anticipated by U.S.

Patent No. 4,759,930 (Granirer) in the light of evidence by Fehr et al. The Office Action states:

Claim [4] is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising rosemary oil and peppermint oil and a carrier wherein controlling comprises knocking down and killing the household pests.

US 4,759,930 discloses a method for controlling household pests or cockroaches comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition in a form or plant blends or powders comprising rosemary oil and peppermint oil and a carrier wherein the controlling effect is knocking down and killing the household pests or cockroaches, for example: see col. 1, lines 62-63 and col. 5-6, examples 15-

The cited patent teaches the use of rosemary and peppermint plant parts or leaves in a form of blends or powders (col. 1, lines 15-45) and it is silent with regard to the oil contents within the rosemary and peppermint plant blends. However, the reference by Fehr et al. demonstrates that the rosemary and peppermint plant blends contain rosemary oil and peppermint oil. Thus, the plant derived materials or plant derived substance based compositions used in the method of the cited patent are considered to be identical to the composition in the presently claimed method because they inherently comprise rosemary oil and peppermint oil and carriers at least to some extent within the meaning of the claims. Further, the final effect of the cited method is killing pests or cockroaches and, thus, it is identical to the effects/results as required by the claimed invention. Therefore, the cited patent is considered to anticipate the presently claimed invention.

Office Action at pages 3-4. Applicants respectfully traverse this rejection.

In particular, Granirer merely discloses a purported *synergistic mixture* of **pyrethrum** containing compositions for killing insects. Claim 4 does not recite a method of using

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pyrethrum-containing compositions. In other words, Granirer does not disclose each and every feature required by pending claim 4. Moreover, Fehr merely provides an analysis of a rosemary oil. Conspicuously absent is any disclosure in Fehr concerning the pesticidal activity, let alone use of pesticidally-effective amounts of rosemary oil containing compositions in a method for controlling household pests, as required by claim 4. As such, Fehr also does not teach each and every feature required by claim 4. Reconsideration and withdrawal of this rejection are respectfully requested.

The Office Action rejects claim 4 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,759,930 ("Granirer") in the light of evidence by Fehr et al. and in the light of evidence by Elamrani et al. The Office Action states:

Claim [4] is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising rosemary oil and eugenol and peppermint oil and a carrier wherein controlling comprises knocking down and killing the household pests.

US 4,759,930 discloses a method for controlling household pests or cockroaches comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition in a form or plant blends or powders comprising rosemary oil and peppermint oil and a carrier wherein the controlling effect is knocking down and killing the household pests or cockroaches, for example: see col. 1, lines 62-63 and col. 5-6, examples 15-

The cited patent teaches the use of rosemary and peppermint plant parts or leaves in a form of plant blends or powders (col. 1, lines 15-45) and it is silent with regard to the presence of oils and eugenol within the rosemary and peppermint plant blends. However, the reference by Fehr et al. demonstrates that the rosemary and peppermint plant blends contain rosemary oil and peppermint oil respectively. The reference by Elamrani et al. demonstrates that eugenol is present in the rosemary oil or in the rosemary plant material. Thus, the plant derived materials or plant derived

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substance based compositions used in the method of the cited patent are considered to be identical to the composition in the presently claimed method because they inherently comprise rosemary oil and eugenol and peppermint oil and carrier at least to some extent within the meaning of the claims. The final effect of the cited methods killing pests or cockroaches and, thus, it is identical to the effects/results as required by the claimed invention. Therefore, the cited patent is considered to anticipate the presently claimed invention.

Office Action at pages 4 and 5. Applicants respectfully traverse this rejection.

The deficiencies of Granirer and Fehr as anticipatory references are discussed above.

Elamrani is not any better. In particular, Elamrani merely discloses a study of Moroccan rosemary oils and their various chemical components. Elamrani nowhere discloses that the characterized rosemary oils may be used in pesticidally effective amounts to control household pests, let alone in combination with other compounds, as required by the method of claim 4.

Reconsideration and withdrawal of this rejection are respectfully requested.

The Office Action rejections Claim 4 under 35 U.S.C. § 102(b) as being anticipated by JP

07145598. The Office Action states:

Claim [4] is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising rosemary oil and peppermint oil and a carrier wherein controlling comprises knocking down and killing the household pests.

JP 07145598 discloses a method for controlling household pests comprising step of applying to a desired pest control location a contact pesticidal composition comprising rosemary oil and peppermint oil and a carrier (see English abstract). The cited patent teaches the disinfecting effect as the result of applying compositions comprising rosemary oil and peppermint oil. Thus, the cited patent is considered to teach controlling pests by killing pests because the disinfecting effect is reasonably expected to provide for pest extermination or killing within the meaning of the claims.

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Therefore, the cited patent is considered to anticipate the presently claimed invention.

Office Action at pages 5 and 6. Applicants respectfully traverse this rejection.

JP 07145598 does not meet the burden of proof establishing a *prima facie* case of anticipation. In particular, JP 07145598 merely relates to impregnated sheet products that may contain rosemary oil as a repellent or disinfectant. JP 07145598 is conspicuously mute on knockdown and kill of insects, much less a method for controlling household pests, as in the presently claimed invention. Reconsideration and withdrawal of this rejection are respectfully requested.

The Office Action rejects claim 4 under 35 U.S.C. § 102(b) as being anticipated by JP 07145598 in the light of evidence by Elamrani et al. The Office Action states:

Claim is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising rosemary oil and peppermint oil and eugenol and a carrier wherein controlling comprises knocking down and killing the household pests.

JP 07145598 is relied upon as explained above. Although it is silent with regard to the eugenol presence in the contents of rosemary oil, the eugenol is inherently present in the rosemary oil-containing composition in the method of the cited patent in the light of evidence by Elamrani et al. which demonstrates that eugenol is an inherent component of the rosemary oil. Thus, the cited patent is considered to anticipate the presently claimed invention.

Office Action at page 6. Applicants respectfully traverse this rejection.

The deficiencies of JP 07145598 and Elamrani are detailed above. To recap, neither of these reference alone disclose each and every element required by claim 4. In other words, the claim method does not necessarily flow from the teachings of either JP 07145598 or Elamrani.

Reconsideration and withdrawal of this rejection are respectfully requested.

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CLAIM REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects claims 4, 19 and 45 under 35 U.S.C. § 103(a) as being unpatentable over JP 07145598 or U.S. Patent No. 4,759,930 (Granirer) in the light of evidence by Fehr et al. and in the light of evidence by Elamrani et al. taken with U.S. Patent No. 6,183,767 (Bessette), U.S. Patent No. 3,761,584 (McGovern) and Ngoh et al. The Office Action states:

Claims are directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising carrier and rosemary oil in combination with one or more compounds selected from the group consisting of eugenol, peppermint oil, phenethyl propionate and benzyl alcohol wherein controlling comprises knocking down and killing the household pests.

JP 07145598 is relied upon as explained above for the disclosure of a method for disinfecting household locations or controlling household pests by killing pests wherein the method comprises step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising carrier, rosemary oil and peppermint oil or a contact pesticidal composition comprising carrier, rosemary oil, eugenol and peppermint oil in the light of evidence by Elamrani et al.

US 4,759,930 is relied upon as explained above in the light of evidence by Fehr et al. and in the light of evidence by Elamrani et al. for the disclosure of a method for controlling or killing household pests wherein the method comprises step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising carrier and rosemary oil in combination with peppermint oil and at least some amount of eugenol.

The cited patents US 4,759,930 and JP 07145598 are lacking disclosure related to the use of phenethyl propionate and benzyl alcohol in the compositions in the method for controlling or killing the household pests.

The following cited references are relied upon for the missing disclosure.

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For example: US 6,183,767 teaches the use of benzyl alcohol and eugenol in the pesticidal compositions that kill household pests (col. 1, line 60, col.3, line 64, col. 4, line 15).

US 3,761,584 teaches that addition of phenethyl propionate into the formulation with eugenol provides synergistic effect for attracting household pests or insects to the location where pest control is desired (abstract).

The reference by Ngoh et al. teaches the killing effect of eugenol and other plant derived benzene derivatives via contact with household pests (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add phenethyl propionate, benzyl alcohol and/or eugenol to the pesticidal compositions comprising rosemary oil and peppermint oil in the method for controlling household pests with a reasonable expectation of success in killing the house hold pests because these compounds have been known in the art of pesticidal compositions and have been used to control or kill the household pests as adequately demonstrated by the cited references. One of skill in the art would have been motivated to add benzyl alcohol and/or eugenol for the expected benefit of killing household pests. One of skill in the art would have been motivated to add phenethyl propionate to the pesticidal composition for the expected benefit to attract the pests to the location designed for pest control by killing with the pesticidal compositions. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art....Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

The claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

Office Action at pages 7-9. Applicants respectfully traverse this rejection.

The Federal Circuit has consistently held that "[a] *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the

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claimed subject matter to a person of ordinary skill in the art." *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976) (emphasis added). *See also, In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("In determining whether a case of *prima facie* obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification." (emphasis added)). In further view of the factual inquiries that must be made in determining the obviousness or non-obviousness of the claims at issue, before the Examiner may combine the disclosures of cited references in order to establish a *prima facie* case of obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). Even assuming, *arguendo*, that a given combination of references is proper, the combination thereof must, in any event, disclose, teach or suggest the features of the claimed invention in order to establish a *prima facie* case of obviousness. *In re Fine*, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Sys. v. Montefiore Hospital*, 221 USPQ 929, 932-933 (Fed. Cir. 1984).

Alone or combined, the applied reference do not establish a *prima facie* case of obviousness because they do not teach, suggest or provide any motivation to one of skill in the art the features required by the claimed methods. In particular, the deficiencies of JP 07145598, Granirer, Fehr and Elamrani are discussed above. Neither Bessette, McGovern nor Ngoh remedy their deficiencies.

Bessette (6,183,767) merely teaches that individual compounds, not essential oils, like rosemary oil, have an ability to interfere with neurotransmitters in certain insects. Bessette does

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not teach or suggest that rosemary oil in a composition of other oils can be used in a method for controlling household pests, as claimed. McGovern fails to remedy the deficiencies of the above-applied references. McGovern merely teaches *attractant* formulation for Japanese beetles only, McGovern does not teach or suggest a method for controlling household pests by using a pesticidally-effective composition containing rosemary oil, wherein knockdown and kill of household pests are achieved, as in the claimed invention.

Ngoh merely discloses insecticidal and repellant properties of certain essential oils against cockroaches. Ngoh nowhere teaches or suggests that rosemary oil containing compositions can be used in a method for achieving fast knockdown and kill of household pests, as in the claimed methods.

At best, one skilled in the art *might* have found it obvious to try various combinations of features taught in the applied references. However, obvious to try is not the standard of 35 U.S.C. § 103. *In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). The applied references simply do not provide any motivation or guidance to one of ordinary skill in the art to reach the claimed method of using a pesticidally effective rosemary oil containing composition, as claimed. Thus, Applicants respectfully request that this rejection be reconsidered and withdrawn.

DOUBLE PATENTING REJECTION

The Office Action rejects claims 4, 19 and 45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,531,163 in view of US 4,759,930. The Office Action states:

The claims in the present application and the patent US 6,531,163 are each drawn to a method for controlling household pests including cockroaches and ants by applying

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to the locus where control is desired a pesticidally effective amount of a composition with peppermint oil and one or more compound selected from the group consisting of eugenol, phenethyl propionate and benzyl alcohol. The claims of US 6,531,163 are broader, they are open to the use of additional materials and they encompass controlling pests including killing pests. The claimed method of the present application is different from the patented claims in that they require addition of rosemary oil to the composition identical to the compositions in the methods of US 6,531,163. However, it is recognized in the art that the pest controlling effects including pest-killing effects are produced by applying the peppermint oil-containing composition together with the rosemary oil-containing composition as adequately demonstrated by US 4,759,930 (see examples 12, 13 and 15-21).

Accordingly, the claimed methods in the present application and the patent US 6,531,163 are obvious variants. Thus, the inventions as claimed are co-extensive.

Office Action at pages 9 and 10. Applicants respectfully traverse this rejection.

The Office Action acknowledges that the claims of US 6,531,163 are devoid of any use of a pesticidally-effective amounts of compositions containing rosemary oil. However, the Office Action improperly combines the teachings US 4,759,930. For instance, the Office Action points to Examples 12 and 13, therein. However, those Examples teach that peppermint and rosemary alone did not knockdown or kill cockroaches after 10 days. Moreover, the Office Action points to Examples 15-21 therein. However the only Examples that exhibit any kill were compositions that contain either boric acid, borax or pyrethrum, which are not a feature required in the pesticidally effective composition of the claimed method. In essence, there is absolutely no basis upon which to predicate the legal conclusion that one having ordinary skill in the art would recognize that the presently claimed invention would have been obvious over the

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methodology claimed in US 6,531,163 or improperly combined with US 4,759,930.

Reconsideration and withdrawal of this double patenting rejection are respectfully requested.

CONCLUSION


If any issues remain outstanding or if an Examiner's amendment could be made to expedite prosecution, then Applicants respectfully invite the Examiner to contact the undersigned representative at the telephone number listed below.

Please grant any extension(s) of time deemed necessary for entry of this communication. The Commissioner is hereby authorized to charge any deficiency in the small-entity fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit Account No. 14-1140. Please credit any overpayment of fees to such Deposit Account.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:


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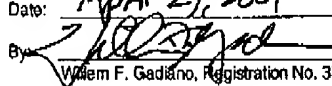
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (703) 872-9306 on the date indicated below, with a coversheet addressed to Commissioner for Patents, U.S. Patent and Trademark Office, Washington, D.C., 20231.

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Willem F. Gadano, Registration No. 37,136